

REMARKS

The Final Office Action mailed October 18, 2007, has been received and reviewed. Claims 1-24 and 26-35 are currently pending in the application. Claims 1-21, 24 and 26-35 stand rejected. Applicant has amended claims 1, 9, 20, 24, 26 and 35, and respectfully request reconsideration of the application as amended herein. Support for Applicant's amendments is found in Applicant's as-filed specification on at least page 2, lines 36-39; page 7, line 32-page 12, line 9. No new matter has been added.

35 U.S.C. § 102 Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 6,539,008 to Ahn *et al.*

Claims 1, 2, 5, 6, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,539,008 to Ahn *et al.* ("Ahn"). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that Ahn does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of amended independent claim 1 and claims 2, 5, 6 depending therefrom, and amended independent claim 35, because Ahn does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

Applicant's invention as claimed generally recites "the ... indications are respectively formed from ... portions of ... *power control bits defined by the system for feedback* for ... transmissions" and "***the ... portions are distributed proportionally differently*** according to different power control modes of the system". Specifically, Applicant's amended independent claims 1 and 35, each recite in part, "*the first and second indications are respectively formed from first and second portions of a plurality of power control bits defined by the system for*

*feedback for the plurality of transmissions, wherein **the first and second portions are distributed proportionally differently according to different power control modes of the system***".

In contrast, Ahn generally discloses *changing the quantity* of power control bits that are **generated** in order to affect the power control resolution. Specifically, Ahn discloses generating "power control bits that have independent control information" and changes the rate of the power control bits by *generating fewer bits*. (Ahn, col. 5, lines 41-49).

Clearly Ahn discloses generating power control bits, however, nothing within Ahn discloses "the ... indications are respectively formed from ... portions of ... *power control bits defined by the system for feedback for ... transmissions*" and "***the ... portions are distributed proportionally differently*** according to different power control modes of the system" as claimed by Applicant. Therefore, since Ahn does not disclose "the *first and second indications are respectively formed from first and second portions of a plurality of power control bits defined by the system for feedback for the plurality of transmissions*, wherein **the first and second portions are distributed proportionally differently according to different power control modes of the system**" in as complete detail as claimed by Applicant, Ahn cannot anticipate under 35 U.S.C. §102 Applicant's invention as claimed in amended independent claim 1 and claims 2, 5, 6 depending therefrom, and amended independent claim 35.

Accordingly, such claims are allowable over the cited prior art and Applicant respectfully requests that such rejections be withdrawn.

35 U.S.C. § 103 Obviousness Rejections

Claims 9 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ahn. Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of amended independent claim 1 precludes a rejection of claims 9 and 19 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 1 and claims 9 and 19 which depend therefrom.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of U.S. Patent No. 6,233,439 to Jalali (“Jalali”).

The nonobviousness of amended independent claim 1 precludes a rejection of claim 3 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 1 and claim 3 which depends therefrom.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of Jalali and in further view of U.S. Patent No. 6,259,927 to Butovitsch *et al.* (“Butowitsch”).

The nonobviousness of amended independent claim 1 precludes a rejection of claim 4 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 1 and claim 4 which depends therefrom.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of U.S. Patent No. 6,148,208 to Love (“Love”).

The nonobviousness of amended independent claim 1 precludes a rejection of claims 7 and 8 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 1 and claims 7 and 8 which depend therefrom.

Claims 10-13, 15-18, 20, 24, 26 and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of U.S. Patent No. 6,590,873 to Li *et al.* (“Li”).

Regarding claims 10-13, 15-18 and 27-34, the nonobviousness of amended independent claim 1 precludes a rejection of claims 10-13 and 15-18 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See*

In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 1 and claims 10-13, 15-18 and 27-34 which depend therefrom.

Regarding amended independent claims 20, 24 and 26, to establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of amended independent claims 20, 24 and 26 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations. Regarding amended independent claims 20, 24 and 26, Applicant has amended independent claims 20, 24 and 26 to include claim limitations not taught or suggested in the cited references.

Again, Applicant’s invention as claimed generally recites “the ... indications are respectively formed from ... portions of ... *power control bits defined by the system for feedback* for ... transmissions” and “***the ... portions are distributed proportionally differently*** according to different power control modes of the system”. Specifically, Applicant’s amended independent claims 20, 24 and 26, each recite in part, “the *first and second indications are respectively formed from first and second portions of a plurality of power control bits defined by the system*

*for feedback for the [] transmissions, wherein **the first and second portions are distributed proportionally differently according to different power control modes of the system***".

As stated above and in contrast, Ahn generally teaches **changing the quantity** of power control bits that are generated in order to affect the power control resolution. Specifically, Ahn teaches generating "power control bits that have independent control information" and changes the rate of the power control bits by **generating fewer bits**. (Ahn, col. 5, lines 41-49).

Clearly Ahn teaches generating power control bits, however, nothing within Ahn teaches "the ... indications are respectively formed from ... portions of ... *power control bits defined by the system for feedback for ... transmissions*" and "**the ... portions are distributed proportionally differently** according to different power control modes of the system" as claimed by Applicant.

The Final Office Action cites Li for teaching a "forward supplemental channel."

Therefore, since neither Ahn nor Li teach or suggest Applicant's claimed invention including "the *first and second indications are respectively formed from first and second portions of a plurality of power control bits defined by the system for feedback for the [] transmissions, wherein **the first and second portions are distributed proportionally differently according to different power control modes of the system***", these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in amended independent claims 20, 24 and 26.

Accordingly, such claims are allowable over the cited prior art and Applicant respectfully requests that such rejections be withdrawn.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of Li and further in view of U.S. Patent No. 6,498,785 to Derryberry *et al.* ("Derryberry").

The nonobviousness of amended independent claim 1 precludes a rejection of claim 14 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 1 and claim 14 which depends therefrom.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of Li and further in view of U.S. Patent No. 6,337,989 to Agin (“Agin”).

The nonobviousness of amended independent claim 20 precludes a rejection of claim 21 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 20 and claim 21 which depends therefrom.

Objections to Claims 22 and 23/Allowable Subject Matter

Claims 22 and 23 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicant acknowledges this indication with appreciation, but respectfully asserts that the claims in their present form, along with all other claims presently under consideration, are in condition for allowance.

CONCLUSION

Claims 1-24 and 26-35 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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